

REMARKS

Claims 1, 3-5, and 7 were pending and under consideration in the application.

In the Office Action of August 14, 2009 claims 1, 3-5, and 7 were rejected under 35 U.S.C. §103(a), as being unpatentable over Cariffe, U.S. 6,281,872 (hereinafter, "*Cariffe*") in view of Barrett, et al., U.S. 5,301,036 (hereinafter, "*Barrett*").

Cariffe describes an editor software program for implementing a rotation interface for an image independently of a mirror attribute. In response to a rotation control selection of a current angle of rotation, an image is rotated to the current angle of rotation. *Cariffe*, 1:5-25. In Fig. 2 of *Cariffe*, reproduced below for the convenience of the Examiner, a user interface for the editor software is illustrated, where element 41 is a digitally represented image to be edited. The illustrated image (of flowers viewed through a divided-light window) may be edited by the user who may crop, zoom in or out, cut or paste, rotate, and otherwise edit digitally represented image 41. *Cariffe*, 2:15-40.

As the Office Action conceded, *Cariffe* fails to teach or suggest an image-processing unit operable to perform any combination of (i) rotating a print-medium image, (ii) rotating a print image, and (iii) simultaneously rotating both the print image and the print-medium image.

Moreover, *Cariffe* completely fails to teach or suggest either rotating or even displaying a print-medium image in any manner, both of which features being recited in each of the independent claims. The Office Action's assertions at page 3 to the contrary, that element 41 somehow "shows a print image superimposed on a rectangular frame representing an outline of a sheet serving as a print medium" has no support in the actual disclosure of *Cariffe*. Element 41 is never described in *Cariffe* as being or including a print-medium image. Indeed, the word "medium" is not found in *Cariffe* in any context, nor are possible synonyms such as "paper" or "sheet".

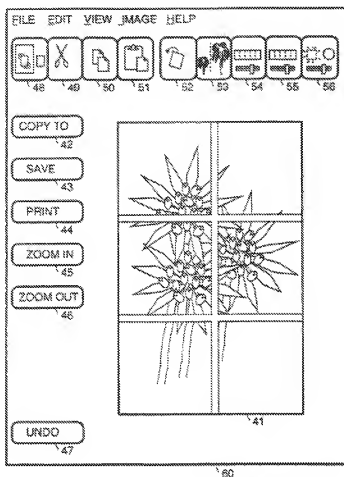


FIGURE 2

To reach a conclusion of obviousness under 35 U.S.C. 103, an examiner is required to “step backward in time and into the shoes worn by a hypothetical “person of ordinary skill in the art” when the invention was unknown and just before it was made.” MPEP, 2142. In view of the factual information present at that time, the examiner is then required to “make a determination whether the claimed invention “as a whole” would have been obvious at that time to that person.” Id. “Knowledge of applicant’s disclosure must be put aside in reaching this determination.” Id. “Impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” Id.

Here, since digitally represented image 41 is never described in *Cariffe* as being or

including a print-medium image, it appears the Office Action relied on Applicant's disclosure and engaged in impermissible hindsight to find that element 41 of *Cariffe* corresponds to Applicants' print-medium image. *Cariffe*, therefore, cannot be relied on for disclosure of (1) displaying and rotating a print-medium image and (2) rotating an orientation of the print medium relative to the print image by a selected rotation angle, as previously recited in each of independent claims 1, 5, and 7.

Barrett fails to cure the foregoing deficiencies. *Barrett* discloses a printing system and rotation/page placement techniques wherein a received digital image is rotated at 90 degree increments in order to provide a desired output orientation and placement. *Barrett*'s disclosure relates to reproduction of printed matter compatible with standard print media where the desired output may have various form factors (e.g., book-form signatures, calendars, etc.). *Barrett*, abstract, col. 1 lines 34-40, and figure 11.

Barrett fails to teach or suggest a display unit that displays a print-medium image and a print image superimposed on a rectangular frame representing an outline of a sheet serving as a print medium, wherein said print image results from rotating the captured image data by a selected rotation angle, said rotation angle being selectable within a range of one to ninety degrees, and an orientation of the print medium relative to the print image is rotated by the selected rotation angle

Because this feature is not taught or suggested by the cited prior art, the Office Action fails to establish that the invention as a whole is obvious in light thereof. See MPEP 2143.03. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F. 2d 1382, 1385.(CCPA 1970)

In view of the foregoing, it is submitted that claims 1, 3-5, and 7 are allowable and that the application is in condition for allowance. Early notice to that effect is respectfully requested.

If the Examiner believes that, for any reason, direct contact with Applicants' attorney would help advance the prosecution of this case to finality, the Examiner is invited to telephone the undersigned at the number given below, for purposes of arranging for a telephonic interview.

Serial No.: 10/823,940

Docket No.: 09792909-5866

Response D, filed November 16, 2009 in reply to non-final Office Action mailed August 14, 2009

Any communication initiated by this paragraph should be deemed an Applicant-Initiated Interview.

If any further fees are required in connection with the filing of this amendment, please charge the same to our Deposit Account No. 19-3140.

Respectfully submitted,

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